

**REMARKS**

Claims 7-12, 28-35, 37-40, 43-47 and 54-56 are pending in the application with entry of this Amendment. Claims 7, 28 and 43 are amended. Claims 1-6, 13-27, 36, 41, 42 and 48-53 were previously canceled. Claims 12 and 29 were withdrawn from consideration. New claims 54-56 are added. The amendments and new claims do not present any new matter. See, e.g., Figs. 29-32. Reconsideration and allowance of the application, as amended, are respectfully requested.

**I. Claims 7, 9-11, 28, 30, 40, 43 and 45-47 Are Novel Over Lundback**

Independent claims 7, 28 and 43 and respective dependent claims 9-11, 30, 40 and 45-47 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 4,736,749 to Lundback (“Lundback”). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP §2131. Applicant respectfully traverses the rejection since Lundback fails to anticipate any claim of the subject application.

Initially, Lundback fails to disclose, teach or suggest the structural configuration of “a suction device connected to the distal end of the tube and having a distal surface” and the “suction device being removably securable to myocardial tissue” as recited in claims 7, 28 and 43. Lundback describes a holder that includes an arrangement 1, an intermediate element 2, and a backpiece 3. The Office Action alleges that the “suction device” as recited in the claims is the collection of the arrangement 1 and the intermediate element 2, and the “tube” as recited in the claims is the hose 8. However, the backpiece 3 in Lundback is rigid and connected to the hose 8. Lundback (col. 3, lines 26-27; a vacuum hose or tube communicating with a vacuum pump or reservoir is connected to the backpiece 3; Fig. 1). The rigid backpiece 3 is not a suction device, and is not the alleged suction device (collection of arrangement 1 and intermediate element 2) asserted in the Office Action. Further, as shown in Fig. 1 of Lundback, the combination of the arrangement 1 and element 2 is not connected to the distal end of the hose 8. Additionally, the backpiece 3 is not removably securable to myocardial tissue, since the backpiece 3 does not contact tissue. (Lundback Fig. 3).

Additionally, as discussed in the November 9, 2006 Amendment, Lundback fails to disclose, teach or suggest a tissue stimulation element that is too small to form a transmural lesion in myocardial tissue disposed “on the suction device distal surface” as recited in claims 7,

28 and 43. Even assuming that the operative part 30 is too small to form a transmural myocardial lesion, the operative part 30 is not disposed on the distal surface of the holder (i.e., lip 13). Rather, as shown in Fig. 1 of Lundback, the operative part 30 is part of arrangement 1, which is not a distal surface. Lundback (col. 3, lines 9-10). The Office Action states that the “distal” surface is the surface closest to the patient, which is contrary to the well understood meaning of “distal” as being situated farthest from a point of reference. The operative element 30 and the surface 4 are not the farthest region or surface from the proximal region of the asserted hose 8 since it is clear that the lip 13 extends farther away from the hose 8. (Lundback, Figs. 2 and 3). Rather, they are intermediate or between the other elements.

In view of these deficiencies, Lundback does not anticipate independent claims 7, 28 and 43. Accordingly, Applicant respectfully requests that the rejection of independent claims 7, 28 and 43 under §102(b) be withdrawn. Dependent claims 9-11, 30, 40 and 45-47 incorporate the elements and limitations of respective independent claims 7, 28 and 43 and, therefore, are also allowable. MPEP §2143.03.

Further, Lundback fails to disclose, teach or suggest the limitation, “wherein the suction device comprises a flexible suction device” as recited in dependent claims 9 and 45. The Office Action asserts that the “suction” device is formed by the collection of the arrangement 1 and the intermediate element 2, but Lundback explains that intermediate element 2 is a “comparatively stiff ring.” Lundback (Abstract). The Office Action has not addressed this fact. Further, Applicant notes that Lundback explains that the backpiece 3 is rigid. Lundback (Abstract).

Lundback also fails to disclose, teach or suggest the limitation, “wherein the suction device is substantially cup-shaped” recited in claims 10 and 46. The Office Action alleges that the arrangement 1 and intermediate element 2 collectively form a cup-shaped suction device; however, arrangement 1 includes an upwardly protruding stem 5, which is not cup-shaped. Accordingly, claims 7, 9-11, 28, 30, 40, 43 and 45-47 are believed allowable over Lundback.

## **II. Claims 8 and 44 Are Patentable Over Lundback and Samson**

Dependent claims 8 and 44 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Lundback in view of U.S. Patent No. 6,185,442 to Samson (“Samson”). The Office Action admits that Lundback fails to disclose a flexible suction tube and cites Samson for this limited purpose. Samson, however, does not provide the above-discussed claim limitations missing in Lundback. Therefore, even assuming *arguendo* the asserted combination were made,

the combination would nevertheless fail to disclose, teach or suggest each limitation of claims 1, 8, 43 and 44 and, therefore, the rejection cannot stand. MPEP §2143.03 (to establish *prima facie* obviousness of a claim, all the claim limitations must be taught or suggested by the prior art).

Accordingly, dependent claims 8 and 44, which incorporate the elements and limitations of respective independent claims 7 and 43, are believed allowable over the cited references.

### **III. Claims 31-33 and 37-39 Are Patentable Over Lundback and Rau**

Dependent claims 31-33 and 37-39 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Lundback in view of U.S. Patent No. 4,685,466 to Rau (“Rau”). The Office Action admits that Lundback fails to disclose certain stimulation electrode dimensions as recited in the claims and cites Rau for this limited purpose. Rau, however, does not provide the above-discussed claim limitations missing in Lundback. Therefore, even assuming *arguendo* the asserted combination were made, the combination would nevertheless fail to disclose, teach or suggest each element of claims 7, 28, 31-33 and 37-39 and, therefore, the rejection cannot stand. MPEP §2143.03. Additionally, while the Office Action states that “Rau provides all of the recited dimensions” on the basis that Rau discloses a needle, Rau does not recite any specific dimensions for the needle, and there is no evidence set forth in the Office Action to establish that the needle described by Rau necessarily has the dimensions as recited in claims 31-33 and 37-39.

Moreover, the basis of the assertion that it would be obvious to combine Lundback and Rau is not clear and believed incorrect. The Office Action alleges that it would have been obvious to modify Lundback as taught by Rau to provide fixation without the need for electrode paste or jelly and to reduce skin resistance. However, Lundback already describes holding the holder by suction (which is accomplished without the need for, or use of paste or jelly). Thus, upon reading Lundback, it is believed that a person of ordinary skill in the art would not be motivated to turn to Rau for this purpose. Alternatively, the Office Action states that a person of ordinary skill in the art would combine Lundback and Rau based on reducing skin resistance. In this regard, Rau is referring to electrical resistance of the skin. Lundback, however, does not even discuss electrical resistance of the skin or that electrical resistance should be reduced. Rather, Lundback refers to resistance in the form of *mechanical forces*. Lundback (col. 4, lines 20-34). Therefore, the required suggestion or motivation to combine the references is lacking. Merely because references can be combined is not sufficient to support the rejection.

Accordingly, dependent claims 31-33 and 37-39, which incorporate the elements and limitations of respective independent claims 7 and 28, are believed allowable over the cited references.

#### **IV. Claims 34 and 35 Are Patentable Over Lundback and Colliou**

Dependent claims 34 and 35 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Lundback in view of U.S. Patent No. 7,020,531 to Colliou (“Colliou”). The Office Action admits that Lundback fails to disclose that the source of stimulation is configured to provide stimulation pulses that are about 1 msec in duration, 10mA and two stimulation pulses per second, and cites Colliou for this limited purpose. Colliou, however, does not provide the above-discussed claim limitations missing in Lundback. Therefore, even assuming *arguendo* the asserted combination were made, the combination would nevertheless fail to disclose, teach or suggest each element of claims 28, 34 and 35. MPEP §2143.03.

Accordingly, dependent claims 34 and 35, which incorporate the elements and limitations of independent claim 28, are believed allowable over the cited references.

#### **V. New Claims 54-56 Are Patentable Over the Cited References**

New dependent claims 54-56 incorporate the elements of respective independent claims 1, 28 and 43 and, therefore, are also believed allowable over the cited references. MPEP §2143.03. Further, Applicant notes that Lundback does not disclose, teach or suggest the limitation, “wherein the suction device defines lumen, and the distal surface carrying the tissue stimulation element extends outwardly beyond lumen,” as set forth in new claims 54-56. Instead, Lundback describes an arrangement 1 that has an operative part 30, but the arrangement 1 has a stem 5, not a lumen. Further, the arrangement 1 does not include the other structural limitations recited in claims 54-56.

**CONCLUSION**

Applicant respectfully requests entry of this Amendment and allowance of the application in view of the forgoing remarks. If there are any remaining issues that can be resolved by telephone, Applicant invite the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

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